

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Fischer *et al.*

Appl. No.: 10/579,099

Filed: March 22, 2007

For: **2-Ethyl-4,6-Dimethyl-Phenyl-Substituted Tetramic Acid Derivatives**

Confirmation No.: 6737

Art Unit: 1626

Examiner: Rodriquez-Garcia, V.

Atty. Docket: 2400.0400000/JMC/THN

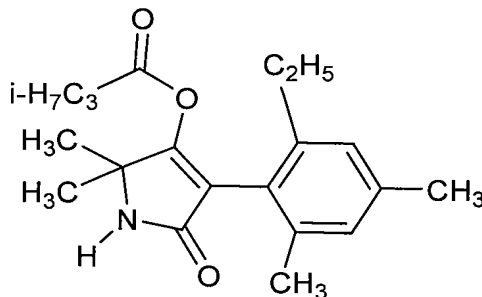
**Reply to Restriction and Election of Species Requirements**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated November 14, 2008, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group **I** represented by claims 1-5 and 8. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

In addition, Applicants provisionally elect the following compound as a single disclosed species:



This compound is described in the table at page 39, paragraph [0694], the first compound, of the published application as Ex. No. I-b-2. This compound is characterized by its melting point presented in the table. Claims 1-6, 8, 9, and 11-15 read upon this elected species. Applicants assert the right to claim additional species in the event that a generic claim hereto is found allowable in accordance with 37 C.F.R. § 1.141(a).

The Examiner further requests to elect a single species as specified at page 4 of the Office Action. Applicants hereby provisionally elect the "drawing of the chemical structure (no variables) of a compound of Formula I (claims 1-6, 8-9, 11)." Claims 1-6, 8, 9, and 11-15 read upon this elected species.

Each of these elections are made **with** traverse. Applicants respectfully submit that restriction to one of eight groups of inventions is not proper.

The Examiner states that "[t]he inventions listed in Groups I-VIII do not relate to a single inventive concept . . . because they lack the same or corresponding technical features." (Office Action at page 3, lines 7-9 from the bottom of the page). Further, the Examiner alleges that the "spyrocyclic [*sic*] pyrrolidin ketoenol core is not considered to contribute an inventive step or concept over the prior art in view that the core is not novel (see WO01/74770A1, supplied in the IDS of 02-22-07 and cited in the International search report. As such, Group I does not share a special technical feature with Groups II-VIII." (Office Action at page 3, the last two lines). Applicants respectfully disagree.

WO 01/74770 A1 does not describe any compound that would fall within the scope of the present claims and, therefore, compounds of formula (I) are novel over WO 01/74770 A1. Applicants respectfully submit that Group **I** shares a specific technical feature with Groups **II-VI**, *i.e.*, compounds of formula (I), and therefore Groups **I-VI** share a single inventive concept.

Further, M.P.E.P. § 803 (Eight Edition, August 2007), at page 800-4, left hand column, states as one of the criteria for a proper requirement for restriction that: "There would be a serious burden on the examiner if restriction is not required . . ." Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such search and examination can be made *without* serious burden. Applicants respectfully assert that the search of restriction Groups **I-VI** does not impose a serious burden upon the Examiner, as search concerning the patentability of invention will clearly uncover art of interest to the other groups.

Thus, Applicants submit that in the present case, restriction to one of eight groups of inventions, as required by the Examiner, is improper and presents an undue burden to Applicants to prosecute eight patent applications. Therefore, it is respectfully requested that at least Groups **I-VI** be examined together. Moreover, it is respectfully requested that at least Groups **I** and **II** be examined together.

The Examiner has stated that in accordance with M.P.E.P. § 821.04 and *In re* Ochiai, rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. (Office Action at page 5, line 11 from the bottom of the page through page 6,

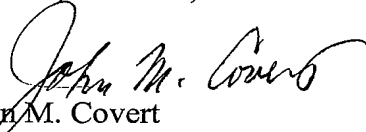
line 8.) Accordingly, Applicants assert the right to rejoinder in accordance with the above policy.

Reconsideration of the Restriction and Election of Species Requirements, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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